

III. REMARKS

Applicant has amended independent claims 1 and 20 to further clarify the difference between "solution- independent intermediate format" and "solution-dependent formatted". No new matter is presented. The amendments to the claims are not intended to be limiting, are not made for reasons related to patentability, and should not be interpreted to raise issues of estoppel.

Applicant has now had an opportunity to carefully consider the Examiner's comments set forth in the Final Office Action mailed March 20, 2007 and responds in detail below. Reconsideration of the application is respectfully requested.

The step of conversion and the action of the converter have now been clarified to indicated that the converted book file is devoid of "particulars unique to the needs of the originator". This is consistent with the disclosure of this application on page 5, lines 11 and 12, as indicated by the Examiner. Applicant submits that this amendment fully remedies the basis for the rejection based on 35USC112.

The examiner in the Response to Arguments section of the subject office action indicates that the feature on which Applicant relies i.e., "all of the pages are processed in the same manner with respect to content", are not recited in the rejected claims. Applicant submits that in making this statement, the Examiner has failed to recognize the significance of certain claim language. For example, claim 1 states:

"b) converting said complete book file to have a solution-independent, intermediate format, in a universal format, wherein said digital structure and codes are devoid of said particulars unique to the needs of the originator"

This indicates that it is the complete book file, including the book block that contains the textual content, that is converted. It also indicates that it is the

digital structure and codes of the complete book file that is altered. There is nothing to indicate that the text is changed at all, much less that the text is divided into separate templates to enable certain variable text to be changed.

It is well settled that the anticipation analysis requires a positive answer to the question of whether the system of Parks would infringe the claims of this application if it were later. All of the claims of this application include the limitation indicated above or its equivalent.

Since the reference Warmus does not disclose or suggest a system having this capability, the system of Warmus would not infringe the claims under consideration. Accordingly, there can be no infringement of the subject claims. Therefore the teaching of Warmus does not support the rejection based on anticipation with respect to any of the claims.

Also in the Response to Arguments section the Examiner indicates that the "stripped template file" may be converted to a PDL or PDF file. Step 42 of the process of Warmus is described at column 7, lines 1-5, as follows:

"The step 42 creates one or more master and variable page files in, for example, a page description language (PDL) such as Postscript.RTM. (PostScript.RTM. is a trademark of Adobe Systems, Inc. for its page description language) representing pages to be produced."

Subsequently, after completion of the process of Warmus, it is stated, at column 7, lines 35-40, as follows:

"The combined files can be then sent to any type of printer or other display device, whether local or remote. Also, the combined files can be converted to a suitable format (e.g., Acrobat.RTM. PDF format) and transmitted to a remote location using a facsimile machine, e-mail, the Internet/World Wide Web or other transmission medium, if desired."(emphasis added)

The Examiner's reference is, therefore, inaccurate. Warmus does not teach that

the "stripped template file" can be converted to a PDF file, but only the completed file. Applicant's assertion, therefore, that Warmus fails to teach that the complete book file is converted, such that the digital structure and codes are devoid of the particulars unique to the needs of the originator (see claim 1 as amended) is correct. Applicant submits further that the separate stripped template text files of Warmus are not the equivalent of the digital structure and codes of the complete book file of the subject application.

Applicant submits that applicant arguments are all based on the limitations that stated in the claims of this application.

The standing rejections are therefore traversed on the same grounds as previously stated and repeated below revised to reflect the above amendments to the claims.

Claims 1-3, 9-22, and 28-38 stand rejected under 35USC102(e) on the basis of the cited reference Warmus et al, U.S. Patent No. 6,332,149.

This rejection is traversed for the following reason:

The cited reference Warmus, et al fails to disclose each and every limitation of the claims of this application. In particular claim 1 as amended states:

"a) receiving, from an originator, as a complete book file, including a book block, and comprising a digital representation, formatted with a digital structure and codes of an originating software, hardware, and operating system, of a book targeted for reproduction, wherein said digital structure and codes includes particulars unique to the needs of the originator;

b) converting said complete book file to have a solution-independent, intermediate format, in a universal format, wherein said digital structure and codes are devoid of said particulars unique to the needs of the originator ;"

and claim 20 as amended states:

- "a) receiving, from an originator, as a complete book file, including a book block and comprising a digital representation, formatted with a digital structure and codes of an originating software, hardware, and operating system, of a book targeted for reproduction, wherein said digital structure and codes includes particulars unique to the needs of the originator;**
- b) converting said complete book file to have a solution-independent, intermediate format, in a universal format, wherein said digital structure and codes are devoid of said particulars unique to the needs of the originator ;"**

The cited reference Warmus et al fails to disclose these claimed features.

the reference Warmus relates to the textual content of a book file while the system and method of this application relate to the digital format and structure, i.e. platform of a book file. The reference Warmus involves a PDL file. A PDL file is defined as follows:

"A page description language (PDL) specifies the arrangement of a printed page through commands from a computer that the printer carries out. Hewlett Packard's Printer Control Language (PCL) and Adobe's Postscript are the two most commonly used PDLS.
(whatis.techtarget.com/)

The use of PDL language indicates the page layout focus of the cited reference. In Warmus, the book is prepared as a template file divided into separate template pages for information that remains the same from one copy to the next and separate template pages for information that varies from one copy to the next. The PDL language enables the textual content flexibility to which the system of Warmus is directed. In the system of this application it is the overall

digital platform that is manipulated to allow use of a book file on multiple printing systems.

In Warmus the fixed content portion of the template file is maintained as a separate file "stripped" of the variable content, while the variable content portion of the template file is maintained as another separate file "stripped" of the fixed content. In the system of this application, the originating digital platform of the book file is converted. This is different than stripping the variable content of a file as in Warmus.

The problem to which Warmus is directed is a page file problem dealing with textual content and treats the textual files on a page by page basis, whereas the solution of the subject invention relates to digital platform of the entire book file. Warmus results in the customization of individual pages of a book during printing of multiple copies. In the system of this invention, all of the pages are processed in the same manner, with respect to content, while the entire book file may be transferred and converted to accommodate solution, or platform, or device dependent needs of a particular publisher.

The nature of the stripped working files of Warmus is explained at column 11, lines 10-29. There is no reference to changing digital structure and codes of an originating software, hardware, and operating system. The processing of the page files of Warmus causes an entirely different result than the processing of the book files in this application. Accordingly, the cited reference Warmus fails to disclose all of the limitations of the claims of this application.

Claims 4-8, and 23-27 stand rejected under 35USC103(a) based on the reference Warmus, in view of the cited reference Dickmeyer,et al, U.S. Patent No. 6,413,100. This rejection is traversed for the following reasons:

The reference Warmus does not render claims 4-8, and 23-27 obvious because it fails to teach or otherwise suggest each and every limitation of the claims. It is well established that to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). *See also In re Wilson*, 165 U.S.P.Q. 494 (C.C.P.A. 1970). As detailed above, claims 4-8, and 23-27, as dependent from either claim 1 or claim 20, all recite the conversion of the digital structure and codes of an originating software, hardware, and operating system, of a book targeted for reproduction. The reference Warmus fails to teach or suggest this feature.

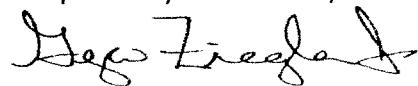
Applicant submits that the above described deficiencies of the primary reference Warmus are not remedied by the proposed combination with the teaching of the reference Dickmeyer. The combined references do not therefore support a *prima-facie* case of obviousness. The modification of the teachings of Warmus or Dickmeyer, in order to obtain the invention, as described in the claims submitted herein, would not have been obvious to one skilled in the art.

For all of the above reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment for any fees associated with this communication or credit any over payment to Deposit Account No. 24-0037.

10/041,081
Response to the Office Action mailed 20 March 2007

Respectfully submitted,



April 18, 2007

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